

BAKER BOTTS LLP  
 Scott Partridge (*Pro Hac Vice* pending)  
 Howard Speight (*Pro Hac Vice* pending)  
 Amanda Woodall Mayor (*Pro Hac Vice* pending)  
 One Shell Plaza  
 910 Louisiana Street  
 Houston, Texas 77002-4995  
 Telephone: (713) 229-1234  
 Facsimile: (712) 229-1522

WINSTON & STRAWN LLP  
 Michael A. Sweet (SBN 184345)  
 101 California Street, Suite 2900  
 San Francisco, California 94111  
 Telephone Number: 415.591.1000  
 Facsimile Number: 415.591.1400

Attorneys for Defendant  
 NCR CORP.

**UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA**

INTELLISYNC CORP., a Delaware  
 corporation,

Plaintiff,

vs.

NCR CORP., a Maryland corporation,  
 Defendant.

**Case No. C04 03804 PJH**

**DEFENDANT NCR CORP.'S NOTICE  
 OF MOTION TO DISMISS**

Complaint Filed: September 9, 2004

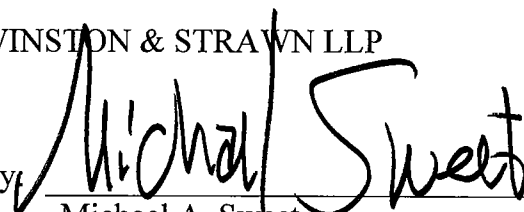
Hearing Date: November 3, 2004  
 Hearing Time: 9:00 a.m.  
 Location: Courtroom 3

PLEASE TAKE NOTICE that a hearing on NCR Corp.'s Motion to Dismiss  
 will be held on November 3, 2004, at 9:00 a.m. Pursuant to Civil L.R. 7-3(a), any opposition  
 to this motion must be filed and served not less than 21 days before the hearing date

Dated: September 29, 2004

WINSTON & STRAWN LLP

By

  
 Michael A. Sweet  
 Attorneys for Defendant  
 NCR CORP.

Winston & Strawn LLP  
101 California Street  
San Francisco, CA 94111-5894

1 BAKER BOTTS LLP  
Scott Partridge (*Pro Hac Vice* pending)  
2 Howard Speight (*Pro Hac Vice* pending)  
Amanda Woodall Mayor (*Pro Hac Vice* pending)  
3 One Shell Plaza  
910 Louisiana Street  
4 Houston, Texas 77002-4995  
Telephone: (713) 229-1234  
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6 WINSTON & STRAWN LLP  
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7 101 California Street, Suite 2900  
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9 Attorneys for Defendant  
10 NCR CORP.

11 UNITED STATES DISTRICT COURT  
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13  
14 INTELLISYNC CORP., a Delaware  
corporation,

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Case No. C04 03804 PJH

NCR'S FED. R. CIV. P. 12(b)(1)  
MOTION TO DISMISS

Complaint Filed: September 9, 2004

Hearing Date: November 3, 2004

Hearing Time: 9:00 a.m.

Location: Courtroom 3

**NCR'S MOTION TO DISMISS  
PURSUANT TO FED. R. CIV. P. 12(b)(1)**

Defendant, NCR Corporation ("NCR"), respectfully moves this Court to dismiss the declaratory judgment claims of Plaintiff, Intellisync Corporation ("Intellisync"), pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure and respectfully would show the Court the following:

**I.  
INTRODUCTION**

This Court lacks jurisdiction over the subject matter of Intellisync's declaratory judgment action against NCR. Intellisync brought this action against NCR seeking a declaration that U.S. Patent No. 6,473,765 ("the '765 Patent") is invalid and not infringed by Intellisync. NCR has attached hereto as an exhibit a Statement of Non-Liability unequivocally stating that Intellisync has no liability either to NCR or to any successors-in-interest to the '765 Patent for infringement of the '765 Patent. Because this Statement of Non-Liability removes any reasonable apprehension that Intellisync will face an infringement suit on the '765 Patent, no justiciable controversy exists between the parties regarding the '765 Patent. Accordingly, this Court lacks jurisdiction over the subject matter of Intellisync's declaratory judgment claims and should dismiss this action pursuant to Federal Rule of Civil Procedure 12(b)(1).

**II.  
ARGUMENT**

A declaratory judgment action may be brought only to resolve an "actual controversy" between "interested parties." 28 U.S.C. § 2201(a). This controversy must be "definite and concrete, touching the legal relations of parties having adverse legal interests," *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 240-41 (1937), and it must be "extant at all stages of review, not merely at the time the complaint is filed." *Presier v. Newkirk*, 422 U.S. 395, 401 (1975). The burden is on the party seeking the declaration "to establish that jurisdiction over its declaratory judgment action existed at, and has continued since, the time the complaint was filed." *Int'l Med. Prosthetics Research Assocs. v. Gore Enter. Holdings, Inc.*, 787 F.2d 572, 575 (Fed. Cir. 1986).

1 The Federal Circuit employs a two part, objective test to determine whether a  
 2 declaratory action involves a justiciable controversy: “there must be both (1) an explicit threat or  
 3 other action by the patentee, which creates a reasonable apprehension on the part of the  
 4 declaratory plaintiff that it will face an infringement suit, and (2) present activity [by the  
 5 declaratory plaintiff] which could constitute infringement or concrete steps taken with the intent  
 6 to conduct such activity.” *Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054, 1058  
 7 (Fed. Cir. 1995).

8 No justiciable controversy exists between Intellisync and NCR in connection with  
 9 the ‘765 Patent. NCR’s Statement of Non-Liability unequivocally states that Intellisync has no  
 10 liability either to NCR or to any successors-in-interest to the ‘765 Patent for infringement of the  
 11 ‘765 Patent:

12 Intellisync Corp. has no liability to NCR Corporation or any  
 13 successors-in-interest to U.S. Patent No. 6,473,765 B1 (the “‘765  
 14 Patent”) for infringement of the ‘765 Patent, and NCR Corporation  
 15 and any successors-in-interest to the ‘765 Patent will not sue  
 16 Intellisync Corp. for infringement of the ‘765 Patent.

17 See Ex. 1 (Statement of Non-Liability). NCR’s Statement of Non-Liability removes any  
 18 “reasonable apprehension” Intellisync may have had that it would be sued for infringement of the  
 19 ‘765 Patent. No actual controversy exists to support subject matter jurisdiction for this action.  
 20 Accordingly, dismissal is required under Rule 12(b)(1) of the Federal Rules of Civil Procedure.

21 The Federal Circuit’s recent decision in *Intellectual Property Development, Inc. v.*  
 22 *TCI Cablevision of California*, 248 F.3d 1333 (Fed. Cir. 2001), further compels this conclusion.  
 23 In *Intellectual Property Development*, the plaintiff filed suit alleging that the defendant had  
 24 infringed its rights in a particular patent. The defendant, in turn, filed a counterclaim seeking a  
 25 declaration that the patent was invalid, unenforceable, and not infringed. After voluntarily  
 26 dismissing its infringement claims, the plaintiff moved to dismiss the defendant’s counterclaim  
 27 for declaratory judgment. Accompanying the motion to dismiss was a “Statement of Non  
 28 Liability” stating that the defendant had no liability to the plaintiff or any successors-in-interest  
 for infringement of the patent-in-issue. *Id.* at 1338. The district court dismissed the action, and  
 the Federal Circuit affirmed, noting that “the statement of non-liability divested the district court

of Article III jurisdiction.” *Id.* at 1342. Notably, the Federal Circuit rejected the defendant’s argument that jurisdiction remained because it could still be required to indemnify third parties sued for infringement of the patent. *Id.* at 1341-42.

As in *Intellectual Property Development*, the Statement of Non-Liability signed by NCR divests this Court of jurisdiction to entertain Intellisync’s declaratory judgment action. Indeed, NCR’s Statement of Non-Liability tracks the language examined by the court in *Intellectual Property Development* verbatim. NCR and all successors-in-interest to the ‘765 Patent are estopped from asserting any claim against Intellisync for past or future infringement of the ‘765 Patent. Accordingly, Intellisync can have no “reasonable apprehension” that it will face an infringement suit, and no actual controversy exists. *Id.*; see also *Super Sack Mfg. Corp.*, 57 F.3d at 1059 (concluding that patentee’s promise not to sue “removes from the field any controversy sufficiently actual to confer jurisdiction” over defendant’s declaratory judgment claim); *Spectronics Corp. v. H.B. Fuller Co.*, 940 F.2d 631, 636 (Fed. Cir. 1991) (finding that patentee’s statement of non-liability eliminated subject matter jurisdiction, even though patent-in-issue was subject of reissue application). Because no actual controversy exists, this Court lacks jurisdiction over the subject matter of Intellisync’s declaratory judgment claims. Intellisync’s complaint for declaratory judgment must be dismissed pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure.


### III. CONCLUSION

For the foregoing reasons, NCR respectfully requests that this Court dismiss Intellisync’s declaratory judgment claims against it pursuant to Rule 12(b)(1) of the Federal Rules of Civil Procedure and for such other and further relief as the Court may deem appropriate.

Dated: September 29, 2004

WINSTON & STRAWN LLP

By:

  
Michael A. Sweet  
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NCR CORP.